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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,976	12/21/2000	Burton J. Carpenter	SC11355TK	8592

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Motorola, Inc.
Austin Intellectual Property Law Section
MD: TX32/PL02
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EXAMINER

THAI, LUAN C

ART UNIT PAPER NUMBER

2827

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,976

Applicant(s)

CARPENTER ET AL.

Examiner

Luan Thai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-7, 9, 10 and 12-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9, 10 and 12-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This Office action is responsive to the amendment filed May 29, 2002.

Claims **1, 2, 4-7, 9-10, and 12-17** are pending in this application.

Claims **3, 8, 11, and 18** have been canceled.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the oxide layer on a *portion of the first surface area around the conductive pad*, as recited in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims **1-2, 4-7, 9-10 and 12-13** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification, as originally filed, does not disclose "*a portion of the first surface area around the conductive pad* being oxidized to provide the first solderability", as recited in independent claims 1 and 10.

Claims **2, 4-7, 9 and 11-13** are rejected since each includes the limitations of independent claims **1 and 10**.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-2, 4-7 and 9** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation in lines 5-6 (i.e., "the first surface area being of a first solderability") and the recitation in lines 11-12 (i.e., "wherein a portion of the first surface area around the conductive pad is oxidized to provide the first solderability") are unclear as to whether oxidizing is performed quite first surface area or just a portion of the first surface area around the conductive pad.

Claims **2, 4-7 and 9** are rejected since each includes the limitations of independent claim 1.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-7, 9-10, and 12-17, insofar as in compliance with 35 USC § 112, are rejected under 35 U.S.C. 103(a) as being unpatentable over LaFontaine et al. (6,130,476 of record) in view of Schrock (6,352,925).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 1-2, 4-7, 9, and 14-17, LaFontaine et al (figures 1-4, specifically figures 3a-3d) disclose an apparatus for interconnecting a semiconductor die to a printed circuit board (PCB) (Col. 3, lines 57+), comprising: an organic substrate 40; a copper trace 60 formed on the substrate having a first surface area being of a first solderability; a conductive pad of nickel 70 formed on the first surface area of the conductive trace, wherein the conductive pad of nickel has a gold layer 80 plated thereon to form a second surface area having a second solderability being greater than the first solderability (since gold has a greater "solderability" than the copper trace 60); a eutectic tin-lead (Sn-Pb) solder bump 30 on the semiconductor die 10 connected to the second surface area without using another material or a solder mask to contain the solder on the second surface area. LaFontaine et al. disclose all the limitations of the claimed invention as detailed above except for a portion of the first surface area around the conductive pad being oxidized (by a native oxide).

Schrock while related to a similar semiconductor structure design teaches a native oxide partially covering the copper traces in order to prevent solder from reflowing to the undesired area on the traces (Col. 2, lines 1+). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Schrock's teachings to LaFontaine et al.'s device structure by forming a

native oxide around the conductive pad for the purposed of preventing the solder from reflowing to the undesired area on the traces.

Regarding claims 10 and 12-13, since the proposed device of LaFontaine et al. and Schrock discloses all the limitations of the claimed structure device as detailed above, it would be obvious for such device being formed by the claimed steps as recited in claims 10 and 12-13.

Conclusion

7. Applicant's arguments with respect to claims **1, 2, 4-7, 9-10, and 12-17** have been fully considered, but they are deemed to be moot in view of the new grounds of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action because the underlined portions of claims 1, 7, 10 and 13-14 raise new issues that would require further consideration and/or search. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan Thai whose telephone number is (703) 308-1211. The examiner can normally be reached on 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Luan Thai
August 9, 2002


KAMAND CUNEO
PRIMARY EXAMINER